

Application No.: 10/028601

Case No.: 55841US002

Remarks**Election/Restriction**

Applicants affirms the election of claims 11-17.

§ 103 Rejections

Claims 11-14 are rejected under 35 USC § 103(a) as being unpatentable over Yoshida (US4931655) in view of Admitted Art. Claims 16-17 are rejected under 35 USC § 103(a) as being unpatentable over Yoshida in view of Admitted art and Kodama (JP-02-188442). Kodama is being relied up for its teaching concerning the use of a UV transmissive filter. Accordingly, both rejections rely on Yoshida as the primary reference.

Accordingly to the MPEP 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second there must be reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.**

The Applicant submits that the disclosure on p. 7 of Applicant's patent application is not "Admitted Art" as alleged by the Examiner. The teachings of Applicant's patent application cannot properly be used as the teaching or suggestion to modify Yoshida to arrive at the claimed invention.

However, as discussed during the interview of October 16, 2003 based on Applicants teaching it would be reasonable for the Examiner to expect that the optical filter described in Yoshida may inherently meets Applicants claimed limitations in view of the lead content.

Although the optimum filter of Yoshida is described at column 3, lines 14-19 as having a lead content of 15-20%, such filter is also described as having 1% cobalt and 1% nickel. As attested to in the attached declaration of Dr. Richard M. Fischer Jr., cobalt and nickel are visible light absorbing components. The presence of visible light absorbing components is undesirable because the presence thereof blocks a portion of the visible light spectrum that is present in natural sunlight. In contrast, the present exemplified optical filter prepared from a glass

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commercially available from Schott Glass Technologies, Inc under the trade designation "Schott WG320" is free of visible light absorbing components. The specification as well as the claims have been amended to reflect this point. The Applicant submits that no new matter has been introduced by amending the specification and the claims in this manner since such compositional limitation is an inherent property of Schott WG320 glass, the glass material employed in the examples as can be determined by routine analysis.

In view of the above, it is submitted that the application is in condition for allowance.

Reconsideration of the application is requested.

Respectfully submitted,

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Date

By: Carolyn A. Fischer

Carolyn A. Fischer, Reg. No.: 39,091

Telephone No.: (651) 575-3915

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833